

REMARKS

Objection

The examiner objected to claims 33, 34 and 59-74 for referring to a "prostate tumor cells encoding" a protein having the amino acid of SEQ ID NO:2. Applicants have amended the claims to delete the phrase "encoding a protein having the amino acid sequence of SEQ ID NO:2" Applicants request that this rejection be withdrawn.

Rejections Under 35 U.S.C. §112, first paragraph (written description)

The Examiner rejected claims 33, 34 and 59-74 as allegedly not supported by an adequate written description. The Examiner argued that the specification does not provide written description support for the phrase "prostate tumor cells encoding a protein having the amino acid of SEQ ID NO:2". It is Applicants' position that the specification provides written description support for prostate tumor cells expressing protein having the amino acid sequence of SEQ ID NO:2. In fact, Table 4 of the specification presents the results of studies showing that alpha-methylacyl-CoA racemase protein is over-expressed in prostate cancer and prostate cancer metastasis.

However, Applicants have amended the claims so that they do not refer to SEQ ID NO:2. In view of this, Applicants request that the rejections under 35 U.S.C. §112 be withdrawn.

Rejections Under 35 U.S.C. 103

The Examiner rejected claims 33, 34 and 59-74 as obvious in view of U.S. Patent 6,395,278 taken with U.S. Patent No. 5,968,737, Sambrook et al. and Ramsay et al.

The claims have been amended to specify the use of a sample comprising "metastatic prostate tumor cells". As explained in the specification, for example, in Tables 1, 2 and 4, alpha-methylacyl-CoA racemase mRNA (Tables 1 and 2) and protein (Table 4) is expressed at a high level in metastatic prostate cancer. U.S. Patent 6,395,278 discloses that the polypeptide encoded by clone F1-12 (also referred to as P504S) is over-expressed in prostate cancer samples, but does not teach or suggest that the polypeptide encoded by clone F1-12 is over-expressed in

Applicant : Jennifer Richardson et al.
Serial No. : 09/967,305
Filed : September 28, 2001
Page : 7 of 7

Attorney's Docket No.: 07334-312001

metastatic prostate cancer cells. There is no suggestion in U.S. Patent 6,395,278 that an mRNA corresponding to SEQ ID NO:3 is expressed or over-expressed in metastatic prostate cancer cells.

U.S. Patent No. 5,968,737, Sambrook et al. and Ramsay et al. concern methods for using probes to measure expression of genes and are not concerned with alpha-methylacyl-CoA racemase expression in prostate cancer.

Thus, the cited references, no matter how combined, cannot render the present claims obvious. In view this, Applicants request that the rejections under 35 U.S.C. §103 be withdrawn.

No fees are believed due in connection with this amendment. However, please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

24 APRIL 2006



Anita L. Meiklejohn, Ph.D.
Reg. No. 35,283

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906